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Remarks

The Applicant respectfully requests reconsideration and withdrawal of the rejections of record in view of the amendments and remarks in this paper.

35 U.S.C. 112, First Paragraph (Written Description)

The Applicant thanks the Examiner for reconsidering and withdrawing this rejection.

**35 U.S.C. § 103(a) (Obviousness)
Segal in view of Joao and Official Notice**

Claims 1, 19, and 30 and their dependent claims 5-18, 20-29, and 31-64 are pending in the present application. These claims have been rejected as being unpatentable over Segal in view of Joao and in view of Official Notice, in some cases including additional references as well. These rejections are respectfully traversed and urged to be withdrawn in view of the present amendments and remarks.

Segal discloses giving the patient access to a centralized medical record and allowing the patient to contribute to the centralized medical record maintained by covered entities, for example by allowing the patient to add text or records to the centralized medical record. But the resulting supplemented centralized medical record is still a medical record maintained by covered entities. Segal thus does not disclose these aspects of present claim 1:

“inducing said patient to convert said received medical record to a converted medical record in a storage format that is not a medical record received from a covered entity”

or

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storing said converted medical record in a memory that is not a
medical record from a covered entity

as required by present claim 1. Claims 19 and 30 have similar restrictions. Both the physicians using and supplementing the centralized medical record and the entity maintaining the centralized medical record are covered entities, thus not the "service provider" defined in the present claims.

See in particular the following passages of Segal:

Paragraph	Language of Segal
Abstract	"Internet-based software applications and graphical user interfaces that give the patients <u>and physicians</u> access to view and <u>manipulate the information in the clinical database</u> and image archives."
[0021]	"The present invention, referred to herein as Patient Power™, is a method and system for creating, storing, accessing, updating, and distributing patient medical records.... Broadly stated, the present invention provides <u>centralized and focused online medical record</u>"
[0022]	According to a representative embodiment, the components of the present invention are ... a clinical database and graphical user interfaces (GUIs) that give the patients and <u>physicians access to view and manipulate the information in the clinical database and image archives.</u>
[0024]	"The present invention pays primary physicians for ... deciding what data should be included in and excluded from <u>a patient's medical record</u> . For example, if a patient mistakenly omits a chronic condition such as a diabetic ulcer, the physician would direct the

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	patient to include it in <u>the medical record</u> . As another example, if a patient recently underwent heart bypass surgery that produced hundreds of documents, the physician would summarize the event for entry into <u>the medical record</u> . Under the physician's guidance, the patient enters the data into <u>the medical record</u> and owns and controls <u>the entire medical record</u> . In the end, <u>the patient owns a focused medical record</u> that enables the primary physician and other specialists to make efficient medical assessments based on concise medical records.
[0075]	[0075] E-mail server 112, web server 114, and ISP 116 interface with Internet 99 and enable web communication among operations center 100 ... the plurality of primary physicians 106, the plurality of referral physicians 108, and the plurality of patients 110. Clinical database 118 stores medical data and scanned document files in separate accounts for each patient."
[0078]	"the patient's medical data stored in clinical database 118."
[0081]	"Finally, the plurality of primary physicians 106 also accesses and updates patient medical records, as authorized by the patients."
[0082]	"The plurality of referral physicians 108 includes specialists and radiologists who receive through the Internet 99 medical records for further analysis, e.g., second opinions. The plurality of referral physicians 108 may also access and update patient medical records if authorized by the patient."
[0084]	"Users, e.g., patients and physicians, can access clinical database 118, account database 132, image archive 128, web-enabler 104, and expanded memory image archive 105 via the website. * * * Using a series of web pages (described below), users can enter, modify, and obtain information contained in the server databases."

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Ser. No. 10/679,749

[0091]	"My Medical Folder is a software application designed to assist a patient in working with a primary physician <u>to establish a focused medical record</u> . The structure of My Medical Folder <u>generally corresponds to a traditional medical chart and is designed to prompt the patient and physician for information necessary for future diagnoses and care</u> . According to a preferred embodiment, physicians ... assist patients in entering and maintaining <u>medical records</u> in My Medical Folder."
[0106]	"[] The present invention provides the patient with ownership and control of her own medical record, controlling access to the medical records using UPIs, passwords, and physician access codes. Thus, before opening a medical record, a patient must log in and provide the UPI and password. A physician uses a separate access code (and the UPI), which allows access to a patient's record when the patient has granted permission for viewing and/or updating. * * * [T]he present invention easily <u>matches and gathers a patient's records</u> across different proprietary patient information systems, such as non-affiliated clinics and hospitals."

In short, according to Segal the patient has more access to and control over the centralized medical record than before, but any modifications the patient makes are incorporated in the same record, which remains subject to HIPAA. In Segal, the patient is not removing the record from the control of HIPAA and then modifying the record. In Segal the patient is contributing to the medical records of covered entities, which remain such after the contribution is made.

The emphasis of Segal on the patient "owning and controlling" the medical record simply means that the patient has access to the official medical record him- or herself, and can control to whom the medical record is available. See for

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Ser. No. 10/679,749**

example Paragraph [0025] which explains, "As the owner of the medical record, the patient has the option of giving a doctor access to view and update the information." If a physician is updating the information in the medical record, it is a medical record covered by HIPAA because a covered entity is modifying the medical record.

In Segal, "owning and controlling" is in contrast to a traditional proprietary medical record, to which the patient did not have access in the past. See how "proprietary" is used in Segal et al. at paragraphs [0013], [0106]. Paragraph [0013] states, in reference to the prior art, "Each of these telemedicine approaches focuses on the physician's control and use of the medical records, without regard to the patient's access. In fact, as with all medical records, electronic records are proprietary and their contents are owned by the provider producing the images, such as a hospital, clinic, HMO, or practitioner's office. Thus, compounding the problem of fragmented patient records, patients have no ownership control with which to consolidate the records."

The other prior art applied in the rejections does not overcome this shortcoming of Segal. For example, Joao similarly is directed to creation of a centralized medical record.

The alleged Official Notice, use of which is again traversed for reasons previously made of record, also does not address this shortcoming of Segal. Thus, the present claims have limitations that none of the cited prior art teaches. The present rejection should be withdrawn in view of these deficiencies of the prior art as applied.

35 U.S.C. § 132 (Amendments Supported)

Claims 1, 19, and 30 of the present application as amended are shown in the left column below. Each amendment finds support as stated in the right column below.

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Ser. No. 10/679,749

Support for amended claim 1

Claim Language	Support
"the service provider that is not the patient or a covered entity"	See the preamble of the same claim.
<i>In Part b and the similar language in parts c through e and claims 19 and 30,</i> "inducing said patient to convert said <u>received</u> medical record to a <u>converted medical record</u> in a storage format <u>that is not a medical record received from a covered entity</u> by summarizing, abstracting, retyping, redacting, supplementing, organizing, or selecting the medical record, without the service provider modifying the information or its format in the <u>received or converted</u> medical record"	This is just additional language distinguishing: (1) the received medical record obtained or received from a covered entity from (2) the converted medical record converted by the patient (thus not a medical record received from a covered entity). A "converted ... medical record" is supported for example, in Par. [0016], [0018], [0026], [0044], [0059]. The concept that a converted medical record received from the patient is not a medical record received from a covered entity is supported by Par. [0037]

Support for Claim 19

19c. "said service provider inducing said patient to store said <u>converted</u> medical record in a memory in said storage format, wherein the <u>converted</u> memory is accessible to the service	In addition to the support pointed out above, the concept that "the converted memory is not under restriction by the Health Insurance Portability and Accountability Act of 1996" is
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<u>provider that is not the patient or a covered entity and the converted memory is not under restriction by the Health Insurance Portability and Accountability Act of 1996."</u>	supported by Par. [0036] and [0037].
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Support for Claim 30

A. ... induce said patient to convert said <u>obtained</u> medical record to a <u>converted medical record</u> in a storage format by summarizing, abstracting, retyping, redacting, supplementing, organizing, or selecting the <u>obtained</u> medical record <u>obtained from a covered entity</u> , without the service provider modifying the information or its format in the <u>converted</u> medical record,	"obtained" is supported by claim 30 before the present amendment; "converted" is supported as shown for claim 1
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The amendments in this paper are therefore free of new matter.

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Conclusion

In view of the above remarks, the applicant respectfully requests reconsideration and allowance of all the pending claims (1-2 and 5-64).

The Commissioner is hereby authorized to charge the fee for extension of time, a request for continued examination, and any additional fees or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,

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